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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/706,843

11/12/2003

Barnaby Henderson

05-03-003

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10/16/2006

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EXAMINER

RAYYAN, SUSAN F

ART UNIT

PAPER NUMBER

2167

DATE MAILED: 10/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/706,843

Applicant(s)

HENDERSON ET AL.

Examiner

Susan F. Rayyan

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 5, 10 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9 and 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>05222006</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Response to Applicant's Request for Reconsideration of Election/Restriction Requirements

1. Applicant's election with traverse of Group I (claims 1 – 4, 6 – 9 and 11 – 14) in the reply filed on August 8, 2006 is acknowledged.

Applicant argues that according to MPEP 806.05 (d), the examiner's restriction is improper. In a "subcombination usable together" restriction, the Examiner is required to show, by way of example, that one of the subcombinations has utility other than in the disclosed combination. The Examiner has made no such showing. Instead, the Examiner merely recites the language of claims 1 and 5, without any analysis whatsoever, and without giving any example of another utility. As the Examiner has shown no separate utility, the restriction is improper and should be withdrawn. Full examination of all claims 1 – 16 is respectfully requested. This is not found persuasive for the reasons set forth hereinbelow:

With reference to **"Related Inventions"**, MPEP 808.02 states:

Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. 121 is never proper (MPEP 806.05). If applicant optionally restricts, double patenting may be held. **Where the related inventions as claimed are shown to be distinct under the criteria of MPEP 806.05(c) - 806.05 (i), the examiner, in**

order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

- (A) Separate classification thereof: This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.
- (B) A separate status in the art when they are classifiable together: Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents, which are evidence of such separate status, and also of a separate field of search.
- (C) A different field of search: Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search. Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

The examiner has fulfilled her duties by providing appropriate explanation as to how the related inventions of Groups I and II are distinct **under the criteria of MPEP: 806.05(c) - 806.05(i)**. Please see the highlighted sections:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 – 4, 6 – 9 and 11 – 14, drawn to receiving and storing test results, each test result record associated with a test identifier, **a build version identifier**, and a test result identifier; comparing each test result record with the contents of a test result database, each compiled test result record associated with a test identifier, **a start build version identifier**, **an end build version identifier**, and a test result identifier; the **new compiled test result** record having the same test identifier and test result identifier as the test result record, and having **a start build version identifier corresponding to the build version identifier** of the test result record., **classified in class 707, subclass 203.**
- II. Claims 5, 10 and 15, drawn to receiving and storing test results, **comparing each test result record with the contents of a test result database and modifying the build range of each compiled test result record, classified in class 707, subclass 101.**

The inventions are distinct, each from the other because of the following reasons:

Inventions listed as Group II and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention has separate utility such as follow.

Group I teaches creating and managing a database where product test results are efficiently stored in a database in such a way that the database updates test result (version) entries on the basis of result changes as successive build tests are performed while Group II teaches no such steps of succession of updating test result and no database updating (versioning).

See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Besides that requiring an examiner does not seem to be in conformance with two well known Patent Goals outlined in the published Strategic Plan of the U. S. Patent and Trademark Office, available to the general public at www.uspto.gov. **The purpose of these goals is an efficient and streamlined patent process to reduce the cycle time and improve the quality of a patent issued.** The common sense is also that searching in limited and appropriate areas would turn out a prior art reference faster and thus help close the prosecution of a case earlier.

So in view of the above mentioned MPEP sections and in the spirit of fulfilling stated Patent Goals, the examiner respectfully submits that, the requirement is still deemed proper and is therefore made FINAL.

2. Response to Applicant's arguments concerning the rejection of claims 1-4, 6-9,11-14 under 35 U.S.C. 101 as directed to non-statutory subject matter.

Applicant argues "Examiner alleges that because some test results are discarded the claimed process has no tangible results" and "the Examiner's analysis does not consider the results of the claimed process as a whole". Examiner respectfully disagrees with the Applicant's interpretation of the cited argument and with the Applicant's argument that the claimed process was not treated as a whole.

Examiner argued in the First Office action on page 5 that "the claim does not provide a tangible result for all possible results from the comparison step. For example, a tangible result is not produced if the results of the comparison indicate there is no match between the test identifier of the test record and test identifier of the compiled test result database".

The claims are directed to a method for storing test results in a database, the method comprising:

- a) receiving test results,
- b) storing the test results,
- c) comparing the result record with the contents of a test result database,

c1) if test result record and a compiled test result record have matching test identifiers and matching test result identifiers modify...

c2) if test result record and compiled test result record have matching test identifier and different test result identifiers ...modify ...

There are three possible outcomes with the comparison. The claim provides for two of the possible comparison results (c1,c2). The claim does not provide for the inevitable possibility that when a comparison between the test result record and the compiled test result record results in "no matching test identifier". Although steps c1 and c2 above provide a real world result for those particular steps the claim as a whole does not provide a real world result as the comparison which results in a "no matching test identifiers" provide no real world results. The claim does not provide real world results for all possible results from the comparison step.

Examiner has reviewed the specification and found in paragraph 38 of the specification "A search is made of the temporary table for records that have a test name without a match in the main table. If such records are found then they are added to the main table". In addition, claims 3 -4, 8-9, 13-14 provide for the comparison result indicating "no matching test identifiers". Taking into consideration the citation in the specification and the claims, the Examiner finds the missing comparison step an integral part of the method for storing test results in a database.

DETAILED ACTION

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 - 4, 6-9 and 11-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application with useful, concrete and tangible result.

A practical application can be either physical transformation or a useful, concrete and **tangible** result.

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

The machine-readable medium as recited in the claims 11 - 14 can be a storage medium as well as a "signal bearing medium" or "transmission type medium" as described in applicant's disclosure. These particular sections in the disclosure refer to "communication media." Claim 11, and other claims that depend in it, are not patent eligible because the invention recited therein is not tangibly incorporated in a computer readable storage medium.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Contact Information


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Rayyan whose telephone number is (571) 272-1675. The examiner can normally be reached M-F: 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Susan Rayyan

October 10, 2006


SHAHID ALAM
PRIMARY EXAMINER